Law, Fact, and Patent Validity

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This article analyzes the murky distinction between questions of law and fact in in patent litigation. It focuses in particular on the issue of patent validity, where the Federal Circuit's case law is in disarray. For instance, enablement, which presents the seemingly factual question of whether a PHOSITA could have recreated the invention, is considered to present a question of law. Yet the related requirement of written description is considered to present a question of fact, even though it requires the decisionmaker to merely compare two documents (the original application and the issued patent)—a task commonly performed by a judge as a matter of law. Similarly questionable rules governing the law-fact boundary exist in many areas of patent doctrine, including nonobviousness and patentable subject matter.

Scholars have often questioned whether there is any ontological distinction between issues of law and fact, and the blurry lines in the realm of patent validity support that theoretical argument. Yet courts' characterization of an issue as factual or legal has serious consequences for the parties to a case and for the litigation process more broadly. Among other things, it dictates the stage at which an issue can be decided, whether the parties have a right to a jury trial, the standard of proof, and the standard of appellate review. Those procedural considerations are particularly important in patent disputes, where the cost of litigation is high, juries decide some issues of patent validity but judges decide others, and a heightened standard of proof applies to certain aspects of certain invalidity defenses.

This article seeks to provide a comprehensive critique of the Federal Circuit's case law on the law-fact distinction and to sketch a better path forward. To begin, the article argues that the Federal Circuit should simply pay more attention when addressing the law-fact divide. Many of the relevant rules have emerged by mere happenstance or are grounded in dated precedent that has been undermined by subsequent developments in patent doctrine. More fundamentally, the article emphasizes that, whether or not the distinction between law and fact is ontologically meaningful, courts' choice about placing an issue in one category or another is, ultimately, a policy choice about how, when, and by whom a particular ruling is optimally made.